

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CRAIG H. EDWARDS

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Appeal No. 96-4136  
Application 08/157,688<sup>1</sup>

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ON BRIEF

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Before CALVERT, McQUADE and NASE, Administrative Patent Judges.  
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 5, all of the claims in the application.<sup>2</sup>

Claims 1 and 2 are illustrative of the subject matter in issue:

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<sup>1</sup>Application for patent filed November 24, 1993.

<sup>2</sup>After final rejection, the claims were amended by an amendment filed on August 3, 1995 (Paper No. 10).

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1. A bicycle fork and handlebar stem assembly including a stem mounting device, comprising:

a fork tube, a portion of which has a cylindrical inner surface, said fork tube portion comprising means for allowing said fork tube portion to be displaced perpendicular to its axis;

a handlebar stem having a hollow portion defining an inner wall which fits around said fork tube portion; and

an expanding means which fits within said cylindrical inner surface of said fork tube portion and, when operated, expands laterally of said fork tube and displaces said fork tube portion laterally against said inner wall of said handlebar stem hollow portion.

2. A bicycle fork and handlebar stem assembly as in claim 1, wherein said means for allowing said fork tube to be displaced perpendicular to its axis comprises at least one longitudinal slot formed in said fork tube portion.

The references applied by the examiner in the final rejection are:

Leaycraft	667,232	Feb. 05, 1901
Schneider	5,201,243	Apr. 13, 1993
		(Filed Jun. 10, 1992)
Edwards	5,251,494	Oct. 12, 1993
		(Filed Sep. 18, 1992)

The claims stand finally rejected as follows:

(1) Claims 1 and 3, anticipated by Schneider, under 35  
U.S.C. § 102(e).

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(2) Claims 2, 4 and 5, unpatentable over Leaycraft in view of Edwards, under 35 U.S.C. § 103.

Before considering these rejections, we note that one of the issues specified and argued by appellant in his brief is the "premature and improper imposition of a Final Rejection" (page 4). However, as pointed out by the examiner on page 9 of the answer, this is a matter which is petitionable, not appealable, and this Board has no jurisdiction to consider it. MPEP § 706.07(c); *Ex parte Jackson*, 1926 C.D. 102, 104 (Comr. 1924).

Rejection(1)

The basis of this rejection is set forth on page 4 of the examiner's answer. The crux of the question involved here is whether Schneider discloses a fork tube 85 (Fig. 5) which "compris[es] means for allowing said fork tube portion to be displaced perpendicular to its axis" and an "expanding means which . . ., when operated, . . . displaces said fork tube portion laterally against said inner wall of said handlebar stem hollow portion", as called for by claim 1.

In discussing the operation of the stem attachment shown in Fig. 5, Schneider states at col. 9, lines 27 to 38 (emphasis added):

To attach the handlebar stem to the bicycle, the inner core 84 and outer core 87 are slipped over the fork pipe 85, and the handlebar stem is lowered until the bearings housing's 89 race of the cone 79, is seated on the bearings 89. The bolt 91 is then tightened, thereby drawing up the wedge nut 93 against the interior diameter of the inner core 84 and causing the interior diameter of the inner core 84 not only to expand, but to rise slightly, clamping the core 83 to the fork pipe 85. The inner core 84 is slit on its sides, preferably symmetrically at two or four locations, at its lower end to facilitate its expansion in the clamping mode.

Schneider does not expressly disclose any displacement of the fork tube 85 perpendicular to its axis, i.e., laterally, but this is not conclusive on the issue of anticipation, since a reference may still anticipate a claim limitation if that limitation is inherently disclosed. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); Verdegaal Bros., Inc. v. Union Oil Co. of Calif., 814 F.2d 628, 633, 2 USPQ 1051, 1054, (Fed. Cir), cert. denied, 484 U.S. 827 (1987).

The examiner finds in effect that when the interior diameter of Schneider's inner core 84 is expanded, as disclosed *supra*),

the fork tube 85 will inherently be laterally displaced because the core 84 bears against its inner surface. As the examiner states on page 7 of the answer, he considers "the ability of the material [of the fork tube] to expand when loaded to be the means for allowing said fork tube portion to be displaced perpendicular to its axis".

We agree with the examiner that when the inner core 84 of Schneider is expanded, as disclosed, it would appear that its pressure against the inner wall of the fork tube 85 would inherently cause some expansion of the latter. However, since any such expansion would be on a microscopic scale, we do not consider that it would meet the quoted limitation of claim 1<sup>3</sup>.

It is fundamental that the claims of a pending application will be given their broadest reasonable interpretation consistent with the specification. In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). In the present case, taking into account the fact that appellant's disclosed means for allowing the fork tube to be laterally displaced constitutes slots 23 in

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<sup>3</sup>Since Schneider discloses that core 84 is preferably made of brass (col. 9, line 2), it would seem that any expansion of fork tube 85 would be particularly small.

the fork (Fig. 3), we conclude that one of ordinary skill in the art would not interpret the claimed "means for allowing" as including apparatus such as that disclosed by Schneider in which the fork tube is not modified for the purpose of allowing any expansion, and the only expansion of the fork tube would be extremely small. We do not regard the examiner's interpretation of claim 1 as a reasonable one, under the circumstances.

Accordingly, the rejection of claim 1, and of claim 3 dependent thereon, will not be sustained.

Rejection(2)

The basis of this rejection is stated on pages 5 and 6 of the examiner's answer. In essence, the examiner takes the position that in view of Edwards' disclosure that wedge nuts and core nuts are equivalent structures known in the art for attaching together the stem and fork tube of a bicycle, it would have been obvious to one of ordinary skill in the art to substitute the wedge nut 36 fixing means of Edwards (Fig. 3) for the wedge-shaped expansion member 7 of Leaycraft, which, upon tightening of nut 11, moves upwardly within the slotted upper end of fork tube 3 to expand the tube outward into engagement with the inner wall of handlebar stem 5 (page 1, lines 38 to 46).

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We note that the Edwards reference is appellant's own patent, and was issued less than one year prior to the filing date of the instant application. It therefore does not qualify as prior art as to appellant under 35 USC § 102(a), (b) or (e). In the absence of Edwards, there is no basis for the examiner's holding that the claimed subject matter would have been obvious, and the rejection under 35 USC § 103 will not be sustained.

Conclusion

The examiner's decision to reject claims 1 to 5 is reversed.

Reversed

IAN A. CALVERT	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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